

REMARKS/ARGUMENTS

Claims 1-7, 9-15, 17, 18, 25-31, 33, 35, 37-39 and 41-52 remain in the application for further prosecution.

Claim Rejections Under §103

Claims 1-7, 9-15, 17, 25, 31, 33, 35, 37-39, 41 and 43-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,857,958 (“Osawa”) and further in view of U.S. Patent No. 5,851,010 (“Feinberg”).

Claims 18 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Osawa and Feinberg as applied to claims above, and further in view of U.S. Patent No. 6,311,976 (“Duhamel”).

Request For Reconsideration of the Rejections

There are several different bases for finding that the claims are patentable over Osawa and Feinberg. Applicants respectfully request that the current claim rejections be reconsidered in light of these arguments.

A. **Osawa Does Not Teach the Claim Elements Related to the “Reset” Feature in the Independent Claims**

Each of claims 1 and 25 requires that “the accumulation feature is reset to include no accumulated game-play elements prior to **each** purchased series of plays.” The Office Action cites to Col. 11, line 47 to Col. 12, line 47 for this feature. However, this element is not taught in Osawa.

Recognizing that prior art systems fail to maintain player interest in a game, Osawa wants to encourage a player to stay at the gaming machine and continue wagering on the primary game. Col. 1, line 45. Osawa does so by providing a secondary game in which elements from the primary game are accumulated and displayed to the player. See FIGS. 6-13. To the extent the player accumulates a certain amount of elements, the player is awarded a prize associated with that secondary game.

One major difference between the claimed invention and Osawa's teaching relates to the resetting function associated with the accumulation feature. In the claimed invention, the reset

function occurs “prior to **each** purchased series of plays.” (i.e., before the player purchases the series of plays). Quite to the contrary, the reset function in Osawa **only** occurs when the accumulated feature reaches a certain threshold. This concept is also taught at column 4, lines 6-18 of Osawa in which Osawa describes resetting one single area in response to the predetermined condition being satisfied (i.e., a win) or resetting all of the display areas in response to the predetermined condition being satisfied.

Osawa’s FIG. 5 further illustrates the process of having the player insert a coin and play the game. In FIG. 5, the reset of the accumulation feature **only** occurs when the secondary game has been completed (by achieving a certain predetermined condition) and the player is awarded a payout, as is shown in steps ST12 and ST13. **There is absolutely no resetting of the accumulation feature prior to the insertion of the coin at step ST1 in FIG. 5.**

Applicant note that, when attempting to find this claim element in Osawa, the Final Office Action states:

Furthermore, Osawa’s accumulation feature provides the player with a second award to a player in response to a predetermined condition being met, **the accumulation feature is reset to include no game played accumulated elements at the start of a player entering into the game.**

Final Office Action, p. 3. The Applicant respectfully suggests that the highlighted portion of this quotation is an inaccurate reading of Osawa. As described above, Osawa **only** resets after a player has achieved a certain outcome in the secondary game -- not “at the start of a player entering into the game.” As such, Osawa does not teach at least one element of claims 1 and 25.

Similarly, independent claims 48 and 51 require “resetting the accumulation feature to include no accumulated game-play elements prior to the **next** purchased series of plays.” For similar reasons, Osawa does not teach this claim element as well.

The Applicant respectfully requests that the Examiner consider the following point very carefully because it helps to establish the Applicant’s frame of mind at the time of the claimed invention. The Applicant was well aware of other prior art accumulation features when the present invention was developed. The Applicant described several prior art wagering games that included an accumulation feature in the Background Section of the present specification. See paragraph 4 of U.S. Publication No. 2003/0157978. The Applicant further noted the

problems associated with the prior art wagering games having such an accumulation feature. See paragraph 5 of U.S. Publication No. 2003/0157978. One of these problems is the concept of the “vulturing” effect, which occurs when a player has nearly achieved a predetermined condition in an accumulation feature, but must walk away from the gaming machine for a variety of reasons (e.g., to eat, to use the restroom, lack of money, etc.). Other players near the gaming machine that has nearly achieved the predetermined condition begin to act like “vultures,” waiting for (or even pressuring) the initial player to leave the machine. **Osawa teaches the EXACT prior art accumulation feature that the Applicant discussed in the Background Section at paragraph 4 & 5 and that the Applicant sought to avoid when developing the current invention.**

Because Osawa only resets the accumulation feature in response to a player achieving a predetermined condition in the accumulation feature, a player of Osawa’s game will be encumbered by the “vulturing” effect that the Applicant described in the Background Section.

In short, Osawa never identified these problems of the accumulation feature and, therefore, cannot teach the solution that has been claimed by the Applicant

B. **Osawa Does Not Teach the Element of Independent Claim 51 Regarding the “Playing” of the Bonus Game and “Returning” to the Basic Game**

Claim 51 permits the player to play the bonus game after a predetermined criterion has been met in the accumulation feature. Furthermore, after completion of the bonus game, the player then returns to the basic game and continues using the same single wager that the player initially used to play the basic game. In particular, claim 51 requires the following:

- “before completing the series of plays of the basic portion of wagering game, **permitting the player to play a bonus game** in response to a predetermined criterion being met for the accumulated element;
- **after completion of the bonus game, returning to the basic portion of the game** to continue playing the series of plays associated with **the single wager** until the fixed number of plays have been completed;”

There is absolutely no bonus game (or secondary game) that can be “played” in Osawa. Rather, it is simply an additional award. Furthermore, as discussed above, in Osawa, there is no returning to the basic portion of the game that permits a player to play the basic game with the same **single wager** that the player previously used to start the basic game. Osawa's FIG. 5 proves that this is true.

The Applicant notes that the Final Office Action fails to address these important claim elements in claim 51. The concepts of “playing” a bonus game, “completing” the bonus game, and “returning” to the basic portion of the game for continuing the play with the single wager are simply not addressed in the Final Office Action. Accordingly, a *prima facie* case of obviousness has not been established with regard to independent claim 51 and its dependent claims for this reason as well.

C. Osawa Teaches Away from its Combination with Feinberg

The objective of Osawa is to enhance player interest in the wagering game to increase the amount of coin input to the gaming machine. Osawa summarizes his wagering game as follows:

As described above, the secondary game played on the secondary display screen is separate from the variable display that displays the principal game, but is related to the result of the principal game, **thereby enhancing the player's interest in continuing to play the entire game.** The secondary game on the secondary display screen proceeds while indicating histories of the (winning) states displayed in the past by the variable display. Therefore, the player can know whether the completion of the secondary game is near or not. Also, it is easy for the player to know at glance what kind of (winning) pattern has to be displayed in the principal game for completion of the secondary game **so that the player may play the game with high interest and expectation.** The player can endeavor to win the principal game by paying attention to the progress of the secondary game, thereby greatly elevating the player's interest in the game.

Col. 15 lines 1-13. (emphasis added). The displaying of the state of completion of the secondary game creates the “vulturing” effect discussed above (and described in the Applicant's specification at paragraph 5) because other people near the gaming machine can also view the state of the secondary game and hope that the player leaves the gaming machine. More importantly, to the extent that Feinberg's single-wager wagering feature were added to Osawa, Osawa's objective of creating more coin input by enhancing player interest through expectations associated with Osawa's secondary game is destroyed. Recognizing Osawa's desire for higher coin-input, it would be counterintuitive for the skilled artisan to modify Osawa and add Feinberg's single-wager betting feature. See MPEP 2143.01 (the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of

a reference). Considering these countervailing themes, the Applicant respectfully suggests that the present rejection may be based on the hindsight reconstruction of the Applicant's invention.

D. Feinberg Teaches Away from the Present Invention And Teaches Away from Its Combination with Osawa

In the previous reply, the Applicant set forth several reasons why the Feinberg teaches away from the combination with Osawa. One those arguments was based on the fact that Feinberg desired a simplistic game format that was easy to use and fair for all players, including novice players. See Reply to the Office Action, dated January 29, 2008, pp. 11-14. In response, the Final Office Action suggests that the argument regarding Feinberg's explicitly recited desire for simplicity is irrelevant to the obviousness rejection of the instant claimed invention. Final Office Action, p. 8. The Applicant respectfully disagrees.

Without question, the pending claims are directed to wagering games that Feinberg would surely consider complex -- the exact type of games that Feinberg understood was in the prior art and was attempting to avoid. See Col. 1, lines 10-25 (Feinberg discussing the problems of common wagering games, such as blackjack, craps. Roulette, baccarat, and slot machines) Some of the prior art games that Feinberg specifically desired to avoid are, in fact, explicitly set forth in several claims. See claims 2, 17, 26, 41. Without question, Feinberg's desire for a "relatively simple gaming format" (col. 1, lines 30-34) in which the outcome is either "you win" or "you lose" is the antithesis of the claimed invention **and** Osawa's teaching in which there are **multiple** types of winning outcomes that are indicated by **multiple** types of symbol combinations. In short, Feinberg's wagering feature for his "relatively simple gaming format" can be excised from Feinberg's wagering system without regard to Feinberg's overall teaching and be added to Osawa. Adding pieces of the prior art together in a piecemeal fashion, without regard to their entire teachings, is improper. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). See MPEP § 2141.02 and MPEP § 2145 X(D)(1).

Consequently, the Applicant respectfully requests the Examiner to reconsider whether the skilled artisan, after reading all of Feinberg, would simply add Feinberg's wagering feature to Osawa in light of the fact that Osawa's objective is to increase repetitive coin input (See step

ST1 in FIG. 5 of Osawa) by enhancing player interest in a wagering game that Feinberg, himself, deemed to be too complex and problematic for novice players.

E. The Stated Reasoning for Combining Feinberg with Osawa is Not Entirely Accurate Because It Misinterprets Feinberg's Teaching.

Finally, the Applicant does not believe that the reason for combining Feinberg and Osawa is entirely accurate. In the Final Office Action, the motivation for making this combination is described in the following two sentences:

Feinberg teaches that one would be motivated to incorporate the wagering system of purchasing a series of plays for a single wager in order to encourage new players to play a wagering game more times and have the ability to assess to ascertain the maximum loss that he/she would have to risk. Therefore one would have been motivated to incorporate the wagering system of Feinberg in order to promote the play of a wagering game at the time the invention was made.

Final Office Action, p. 4. As stated previously, Feinberg's objective is to attract new players by providing a wagering game that is unlike other well-known wagering games. To accomplish this objective, Feinberg's focus is on a "relatively simple gaming format" **in which the player makes a simple decision**, such as odd/even, red/black, heads/tails. See Col. 1, lines 30-34; Col. 2, lines 38-50. By providing a wagering game that relies on such a simple decision from the player, Feinberg is removing the complex gaming rules associated with other more well-known wagering games, thereby making a new player more comfortable with understanding how to play Feinberg's game. While Feinberg's simple wagering game calls for the player to make a single wager, Feinberg **is not teaching** a "single wager in order to encourage new players to play a wagering game" as set forth in the Final Office Action. Rather, Feinberg is teaching a simplistic gaming format that requires a straightforward odd/even, red/black, heads/tails type of decision from the player for encouraging new players to play Feinberg's wagering game.

As such, Applicant does believe the first sentence in the aforementioned quote regarding what Feinberg is teaching is an entirely accurate statement. Hence, it should not be used as the basis for the reasoning as to why to add Feinberg to Osawa.

Conclusion

It is the Applicant's belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicant's undersigned attorney at the number shown.

Respectfully submitted,

Date: October 21, 2008

/Daniel J. Burnham, Reg. #39,618/

Daniel J. Burnham

Reg. No. 39,618

NIXON PEABODY, LLP.

161 N. Clark Street, 48th Floor

Chicago, IL 60601-3213

(312) 425-3900

Attorney for Applicants